



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,389	02/07/2001	Glenn McGall	18547-040820US	6566

33494 7590 12/02/2002

TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FRIEND, TOMAS H F

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/779,389

Applicant(s)

MCGALL ET AL.

Examiner

Tomas Friend

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, second paragraph rejections.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see the attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-13 and 15.

Claim(s) withdrawn from consideration: 16 and 17.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Tomas Friend, Ph.D.
19 November 2002

Art Unit: 1639

Advisory Action

Change of Art Unit Designation

Please note: The Art Unit location of this application in the PTO has changed from Art Unit 1627 to Art Unit 1639. To aid in matching papers to this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

Status of the Application

Receipt is acknowledged of a response to a final office action with amendment on 04 November 2002 (Paper No. 11).

Status of the Claims

Claims 1-17 were pending in the application. Claims 16 and 17 were withdrawn from further consideration in Paper No. 5. Claim 14 was cancelled in Paper No. 7. Claims 1-13 and 15 are pending in the present application.

Request to Withdraw Finality

Applicants have requested the examiner to withdraw the finality of the office action mailed 28 June 2002 (Paper No. 8). Applicants argue that the new grounds of rejection could have been raised previously and were not necessitated by applicants' amendment.

Applicants' argument has been carefully considered but is not persuasive. The rejections of claims 1-3, 8, 13, and 15 and claims 1-3, 10, and 13 under 35 U.S.C. 102(b) and claims 1-3 and 7-15 under 35 U.S.C. 103(a) were withdrawn in response to applicants' amendment to the claims in Paper No. 8. The amendment that necessitated the withdrawal of these rejections necessitated the new grounds of rejection raised. Furthermore, the rejection of claims 4-6 under 35 U.S.C. 103(a) embraces all of the limitations of claims 1 and 3, from which claims 4-6

Art Unit: 1639

depend. Thus claims 1 and 3 were, in effect, also rejected under 35 U.S.C. 103(a) in Paper No. 8 as being unpatentable over Terrett, Fodor et al., and Brennan.

~~The finality of the office action mailed 28 June 2002 is not withdrawn.~~

Withdrawn Rejections

The rejections of claims 7 and 9 under 35 U.S.C. 112, second paragraph, are withdrawn in response to applicants' amendment.

Rejections under 35 U.S.C. 103(a)

Applicants argue that all of the references cited in the outstanding claims rejections under 35 U.S.C. 103(a) are silent with respect to the exclusion of ozone.

Applicants' argument filed 04 November 2002 has been fully considered but it is not persuasive. This is the same argument that applicants made with regard to the rejections of claims 4-6 under 35 U.S.C. 103(a) maintained in Paper No. 8. Relevant portions of the examiner's response to this argument, found in Paper No. 8 are reproduced below for applicants' convenience.

Urdea et al., Column 8, lines 1-37, teaches that pressurized helium gas fills reagent reservoirs, reagent manifold, and reaction column. One of ordinary skill in the art would understand that helium gas at pressures positive pressures ranging from 5-25 psig fill all areas where reagents are stored and where reactions take place. Consequently, one of ordinary skill in the art would reasonably assume that the no ozone is present in the system during oligonucleotide synthesis and that the method inherently meets the presently claimed limitations with respect to ozone concentrations and degradation. One of ordinary skill in the art would have no reason to believe or suspect that pressurized helium contains 5 ppb or more of ozone.

Brennan, Column 8, lines 40-55, teaches that a common chamber containing reaction wells and nozzles is swept with inert gas to remove air and water traces from the chamber and that "oxidation can be minimized, if not eliminated." Thus it would appear that the cited method inherently performs oligonucleotide synthesis at concentrations of ozone that are less than 5 ppb. One of ordinary skill in the art would not expect inert (presumably pure) inert gasses to contain 5 ppb or more ozone.

Art Unit: 1639


It appears that those of ordinary skill in the art at the time that the invention was made were well aware of the need to use inert gasses to protect reactants and products from oxidation. While the references may be silent with respect to ozone levels, the examiner has indicated that pure helium or other inert gasses taught by the prior art of record were not known to contain any amounts of ozone. Applicants have not asserted that the pure helium or other inert gasses contain more than 5 ppb ozone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tomas Friend** at telephone number (703) 308-4548. The examiner's normal schedule is four, ten-hour days per week including Saturdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Tomas Friend, Ph.D.
19 November 2002



ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600